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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,340	02/06/2004	Asutosh Nigam	8500-0256.10	5320

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REED INTELLECTUAL PROPERTY LAW GROUP
1400 PAGE MILL ROAD
PALO ALTO, CA 94304-1124

EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/774,340	Applicant(s) NIGAM, ASUTOSH	
	Examiner Monique R. Jackson	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 21-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 10/17/05 has been entered. Claims 1-62 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

3. Claims 47 and 49-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32 and 34-40 of U.S. Patent No. 6,723,383, for the reasons recited in the prior office action and restated below.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant invention are fully encompassed by USPN '383. The Examiner notes that the instant application is a divisional application of USPN '383 resulting from a restriction requirement, however, it is noted that the elected invention of '383 included the process of the above cited claims with an election of species of polymeric polybase and polymeric polyacid. Considering claim 47 is a generic claim that is not directed to the non-elected species only, the above-cited claims do not correspond to the non-elected invention/species of the parent application and hence a double patenting rejection is appropriate.

4. Claims 1-9 and 21-62 (*as well as non-elected 10-20*) are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 60, 62, 68-70, 80-91, 84, and 90-111 of copending Application No. 10/314855 (now USPN 6,936,316) for the reasons recited in the prior office action and restated below.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time of the invention to combine dependent claim limitations and to utilize any combination of the claimed materials for the opaque coating. Further, the Examiner notes that though the claims of the copending application are directed to a product while the instant claims are directed to the product as well as the process, the instantly claimed process would have been obvious based on the claimed product of '855 considering the instantly claimed process only includes minimal process steps, i.e. printing an image would have been obvious from "a printed image" and applying an opaque coating composition to a substrate would have been obvious from "a substrate coated with...an opaque coating composition."

Response to Arguments

5. Applicant's arguments, see pages 13-14, filed 10/17/05, with respect to the rejections under 35 U.S.C. 112, 2nd paragraph, and the rejections over Netsch et al have been fully considered and are persuasive. The rejections recited in paragraphs 7-15 of the prior office action have been withdrawn. The Applicant's arguments with regards to the double patenting rejection over copending application 10/314855, now USPN 6,936,316, have been considered but are not persuasive. The Applicant argues that a two-way determination of obviousness is required because the '316 application was applied for after the parent of the instant application encompassing further development in the field of the invention, and that it is not the applicants' fault that the '316 patent issued before the claims of the present application. However, as recited previously and restated above, though the instant application is a divisional application of the parent case, the claims of the present application **do not** correspond with the restriction

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requirement. Further, it is noted that the restriction requirement in the parent case was mailed in June 2002, with an election response filed in July 2002, yet the instant "divisional" application was not filed until February 2004, and that during prosecution of the parent case, two extensions of time were requested by the applicant in March 2003 and September 2003 prior to the Notice of Allowance being mailed in October 2003, several months before the February 2004 filing date of the instant application. Therefore, though the claims of the '316 patent may not have been able to have been filed with the parent of the instant application, the Examiner takes the position that any delay in prosecution of the instant claims were not the result of any administrative delay by the Office but in fact due in part to Applicant's control of the rate of prosecution of the instant claims as well as the parent. Hence, only a one-way test is required and the Examiner maintains her position with regards to the obviousness double patenting rejection over the '316 patent.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson
Primary Examiner
Technology Center 1700
January 9, 2006